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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
DE02 0149 US	

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Application Number	Filed
10/517,284	12/08/2004
First Named Inventor	
Matthias Muth	
Art Unit	**Examiner**
2183	Faherty, Corey S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☐ attorney or agent of record. Registration number _____.
- ☑ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 43,654

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May 13, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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PRE-APPEAL BRIEF REMARKS/ARGUMENTS

In the Final Office Action of January 13, 2010, claims 1, 3, 5 and 9-13 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Stolan (U.S. Pat. No. 5,864,663) in view of Juzswik (U.S. Pat. No. 4,698,478). Claims 4 and 6-8 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Stolan in view of Juzswik and further in view of Ubicom (Ubicom Product Report –IP2022 Internet Processor, hereinafter "Ubicom"). However, Appellant respectfully submits that a *prima facie* case of obviousness has not been established with respect to independent claims 1 and 5.

As previously presented in the Response filed on April 13, 2010, Appellant respectfully asserts that independent claims 1 and 5 are not obvious over Stolan in view of Juzswik because the proposed combination of Stolan and Juzswik would change the function of the microprocessor (12) of Stolan. Additionally, as previously presented in the Response filed on November 19, 2009, Appellant respectfully asserts that independent claims 1 and 5 are not obvious over Stolan in view of Juzswik because the proposed modification of Stolan in view of Juzswik would change the principle of operation of Stolan and would also render the invention of Stolan unsatisfactory for its intended purpose.

With regard to the Examiner's reasoning in page 2 of the Advisory Action of April 21, 2010 and pages 5 and 6 of the Final Office Action, Appellant respectfully disagrees with the Examiner's suggestion that the proposed modification of Stolan in view of Juzswik does not change the principle of operation of Stolan. Appellant respectfully asserts that the principle of operation of Stolan involves the microprocessor (12) checking the watchdog timer circuit (10) every millisecond to prevent an undesired reset of the microprocessor (12) and that the proposed modification of Stolan in view of Juzswik would change the principle of operation of Stolan. As noted in MPEP §2143.01 (VI), if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Additionally, Appellant respectfully asserts that the intended purpose of Stolan is to prevent an undesired reset of the microprocessor (12) by checking the watchdog timer circuit (10) every millisecond by the microprocessor (12) and that the proposed modification of Stolan in view of Juzswik would render the invention of Stolan unsatisfactory for its intended purpose. As noted in MPEP §2143.01(V), if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Even if the proposed modification of Stolan in view of Juzswik does not change the principle of operation of Stolan and does not render the invention of Stolan unsatisfactory for its intended purpose, the proposed combination of Stolan and Juzswik would change the function of the microprocessor (12) of Stolan, and thus is not obvious to do so. As noted in MPEP §2143.02, a rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions.

Independent claims 1 and 5 are not obvious over Stolan in view of Juzswik because the proposed combination of Stolan and Juzswik would change the function of the microprocessor (12) of Stolan.

As noted in MPEP §2143.02:

> "A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950)." (emphasis added)

The Final Office Action on page 3 correctly recognizes that "Stolan does not explicitly disclose the steps of supplying a permanent energy supply from a battery unit to the monitoring module; and switching a microcontroller supply unit of the base chip to

enable or disable a temporary energy supply from the battery unit to the microcontroller unit." However, the Final Office Action then alleges that "Juzswik discloses using this technique [col. 2, line 32 – col. 3, line 4] for the purpose of reducing power consumption in a system having a microprocessor and a watchdog timer" and that "[s]uch operation would therefore have been obvious in the system of Stolan."

Stolan discloses a system that includes the microprocessor (12) and a watchdog timer circuit (10). (See Figs. 1 and 2, and column 4, lines 43-65 of Stolan). Stolan further discloses that the watchdog timer circuit (10) includes a counter (18) and that the microprocessor (12) is programmed to check a most significant bit (MSB) status of the counter (18) every millisecond. (See column 4, line 58 of Stolan). Additionally, Stolan discloses that if the MSB is found not to be logic high, the microprocessor (12) sends a count up signal to the counter (18) and exits the counter checking program and that if the MSB is found to be logic high, the microprocessor (12) sends a count down signal to the counter (18) and exits the counter checking program to prevent an undesired reset of the microprocessor (12). (See Fig. 3 and column 5, lines 31-45 of Stolan). That is, Stolan teaches that the function of the microprocessor (12) involves checking the watchdog timer circuit (10) every millisecond.

Juzswik teaches a system for controlling body electrical requirements of an automotive vehicle and monitoring various essential switch conditions to ascertain the level of activity. (See column 2, lines 31-35 of Juzswik). Juzswik further teaches that after the system enters the "sleep" mode, the system will wake up briefly some 600 or 700 milliseconds later and repower the control system sufficiently to again check the essential inputs and return to another sleep mode if no activity has occurred to conserve power. (See column 1, lines 9-11 and column 3, lines 13-18 of Juzswik). That is, Juzswik teaches that the function of the system for monitoring the essential switch conditions involves sleeping and then waking up after 600 or 700 milliseconds to conserve power.

Thus, if the microprocessor (12) of Stolan is combined with the system for monitoring the essential switch conditions of Juzswik, the function of the microprocessor (12) of Stolan would be changed from checking the MSB status of the counter (18) in the watchdog timer circuit (10) every millisecond to checking the MSB status of the counter

(18) in the watchdog timer circuit (10) after 600 or 700 milliseconds of sleep. As a result, the proposed combination of Stolan and Juzswik would prevent the microprocessor (12) of Stolan from checking the MSB status of the counter (18) in the watchdog timer circuit (10) every millisecond. Therefore, Appellant respectfully submits that the proposed combination of Stolan and Juzswik would change the function of the microprocessor (12) of Stolan. Because the proposed combination of Stolan and Juzswik would not result in elements with no change in their respective functions, Appellant respectfully submits that independent claims 1 and 5 are not obvious over Stolan in view of Juzswik.

The proposed modification of Stolan in view of Juzswik would change the principle of operation of Stolan and would also render Stolan unsatisfactory for its intended purpose

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (see MPEP §2143.01 (VI)). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (see MPEP §2143.01(V)).

As described above, Stolan discloses a system that includes the microprocessor (12) and the watchdog timer circuit (10), which includes the counter (18). Stolan further discloses that the microprocessor (12) is programmed to check a most significant bit (MSB) status of the counter (18) every millisecond to prevent an undesired reset of the microprocessor (12). (See Fig. 3 and column 5, lines 31-45 of Stolan). That is, the principle of operation of Stolan involves the microprocessor (12) checking the watchdog timer circuit (10) every millisecond to prevent an undesired reset of the microprocessor (12) and the intended purpose of Stolan is to prevent an undesired reset of the microprocessor (12) by checking the watchdog timer circuit (10) every millisecond by the microprocessor (12). Juzswik teaches that a system for monitoring essential switch conditions sleeps and then wakes up after 600 or 700 milliseconds.

Thus, if the system of Stolan is modified using the technique of entering and exiting the "sleep" mode, as taught by Juzwik, the proposed modification of Stolan in view of Juzswik would result in that the microprocessor (12) checks the MSB status of the counter (18) in the watchdog timer circuit (10) after 600 or 700 milliseconds of sleep. As a result, the proposed modification of Stolan in view of Juzswik would prevent the microprocessor (12) from checking the MSB status of the counter (18) in the watchdog timer circuit (10) every millisecond to prevent an undesired reset of the microprocessor (12). Therefore, the proposed modification of Stolan in view of Juzswik would change the principle of operation of Stolan.

Additionally, the modification of Stolan in view of Juzswik will make it impossible that the watchdog timer circuit (10) is checked every millisecond by the microprocessor (12) to prevent an undesired reset of the microprocessor (12). Therefore, Appellant respectfully submits that the proposed modification of Stolan in view of Juzswik would also render Stolan unsatisfactory for its intended purpose of continuously monitoring the operation of the microprocessor (12) to prevent an undesired reset of the microprocessor (12).

Accordingly, Appellant respectfully submits that the teachings of Stolan in view of Juzswik are not sufficient to render independent claims 1 and 5 *prima facie* obvious.

CONCLUSION

Appellant respectfully requests reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted on behalf of:

NXP N.V.

Date: May 13, 2010

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